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| APPLICATION NO | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO | CONFIRMATION NO |
|----------------|-------------|----------------------|--------------------|-----------------|
| 10 023,357 | 12 17 2001 | Andrea Michalik | 2625-011763 | 2806 |

7590 07 02 2002

Russell D. Orkin
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219-1818

EXAMINER

BELL, KENT L.

| ART UNIT | PAPER NUMBER |
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|----------|--------------|

2661

DATE MAILED: 07 02 2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/023,357

Applicant(s)

MICHALIK

Examiner

KENT L. BELL

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on application filed 12/17/01.
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/17/01 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) (Paper No(s))
- 4) ☐ Interview Summary (PTO-413) (Paper No(s))
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other Rule 1105 Requirement

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Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

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No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

A. The disclosure is objected to under 37 CFR 1.121(e) because the Latin name of the genus and species of the claimed plant and Variety Denomination of the claimed plant should be preceded by a heading as set forth in 37 CFR 1.163(c)(4)(5) and 37 CFR 1.163(d). This information should be set forth before the "BACKGROUND OF THE INVENTION" section as set forth in 37 CFR 1.163(c).

B. Applicant recites "The new variety is a selection from the cross of a set of fourteen proprietary unpatented breeding seedlings.". The recitation stated above does not disclose which of the fourteen seedlings are the parents of the instant plant. Applicant should set forth in the specification the parents of the instant cultivar and set forth which parent was used as the pollen parent and which was used as the seed parent. If the parent plants are unnamed plants within the

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breeding group (breeding seedlings) then a simple statement such as --The new variety is the result of a cross between two unnamed and unpatented selections from the breeding group (insert name of breeding group, if a name was given to it).-- should be set forth in the specification. If the parent plants are named plants within the breeding group (breeding selections) then a simple statement as stated above including the cultivar names should be set forth in the specification. Correction and/or clarification is necessary. The origin of the plant must be clearly and unambiguously set forth.

C. If additional comparative data between the instant cultivar and its parents is readily available then Applicant should import this information into the specification.

D. Page 1, lines 16-22. Applicant should set forth in the specification the age of the plants when described and container size (if grown in a container).

E. Page 1, lines 18-20. Applicant recites "The data which defines these characteristics were collected by asexual reproductions carried out in Dresden, Germany.". Applicant should set forth in the specification the type of "asexual reproductions", i.e. cuttings or other.

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F. When compared to the photographic illustration of record, it appears the leaves have zonation. Further applicant has stated on page 1, line 32 that a zone on the foliage is present. Applicant should set forth in the specification the color designation(s) for the zonation with reference to the employed color chart. Correction and/or clarification is necessary.

G. Page 2, lines 17-19, Applicant should set forth in the specification additional information relative to the instant plant's petioles including the typical and observed petiole diameter, if such information is readily available.

H. Page 3, line 12, Applicant states "Borne: Flowers on umbel; umbel on pedicel; pedicel on peduncle.". This recitation does not appear to be accurate as flowers make up the umbel and flowers are connected to the pedicel not the umbel connected to the pedicel. It appears applicant intended to state --Borne: Umbel; flowers on pedicel, pedicel on peduncle.--. Correction and/or clarification is necessary.

I. Applicant should set forth in the specification the typical and observed number of inflorescences per plant and flowering season.

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J. Applicant should set forth in the specification the lastingness of an individual bloom, on the plant.

K. Page 4, lines 2-12, Applicant should set forth in the specification additional information relative to the instant plant's sepals including the typical and observed margin descriptor.

L. Page 4, line 13-16, Applicant should set forth in the specification additional information relative to the instant plant's petaloids including the typical and observed length, width, and apex, base, and margin descriptors in the interest of providing as complete a description of the plant as is reasonably possible. The recitation "smaller than petals" is vague and insufficient in this regard.

M. Page 4, line 16, Applicant has set forth a color designation for the petaloids but has not specified whether the color designation represents the upper, lower, or both surfaces. Applicant should set forth a color designation(s) for both surfaces in the specification. Color designation(s) should be referenced by the employed color chart.

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N. Page 4, line 23, Applicant should delete "unusual" as this term is vague and meaningless in this instance.

O. Page 5, line 3, Applicant states there are five pistils per flower. Applicant should review the amount of pistils per flower as there may only be one pistil that is five parted. Correction and/or clarification is necessary.

P. Page 5, line 10, Applicant sets forth a measurement but does not specify a dimension, i.e. length, width, etc. Applicant should set forth in the specification a dimension. Correction and/or clarification is necessary.

The above listing may not be complete. Applicants should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

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Claim Rejection

35 U.S.C. 112, 1st & 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

Potential Issue Under 35 U.S.C. 102

The claimed Geranium variety 'Penjul' is described in Breeder's Right application number 981667 filed in The European Community on December 10, 1998 and published on February 15, 1999. The claimed Geranium variety 'Penjul' is also described in Breeder's Right application number OO00777 filed in Poland on April 3, 2000 and published on June 30, 2000. These published applications are each a "printed publication" under 35 U.S.C. 102 because they are accessible to persons concerned with the art to which the documents relate. See *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981). See also MPEP § 2128. For example, UPOV publishes the application number, date of publication, species of plant and variety denomination for PBR certificates, and copies of the European application, 981667, are obtainable through the European Communities Register of Applications for Community Plant Variety Rights. This register is open to public inspection and the information in this register is published every two months. Copies of the Poland application, OO00777, are available to the public similar to other

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countries. Thus information regarding the claimed variety, in the form of the publications noted above, was readily available to interested persons of ordinary skill in the art.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ 2d 1618, 1620, (Bd. Pat. App. & Inter. 1992)("The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether Siokra seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokra cultivar disclosed in the cited publications.").

While the publications cited above disclose the claimed plant variety, a question remains as to whether the references are enabling. If the plant was publicly available, then the applications, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. The ability of the Office to determine whether the claimed plant was publicly available is limited. Search of electronic databases, the internet and the Office's collection of retail catalogs has not revealed any evidence that the claimed plant was on sale anywhere in the world. However, the Office's collection of retail catalogs is not comprehensive. Furthermore, the claimed plant may have been sold at the wholesale level, sold under a different

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name, or even distributed to interested parties free of charge. Since the inventor and assignee of the instant application are in a better position to know when, if ever, the claimed plant was made publicly available, the Examiner is requiring this information in the attached Requirement for Information Under 37 CFR 1.105.

This Office action has an attached requirement for information under 37 CFR 1.105. A complete reply to this Office action must include a complete response to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

Comments

Due to the amount of revision seen necessary in this application, it is suggested that Applicant file a substitute specification, incorporating all additions, deletions and modifications so as to provide the printer a clean copy at the time of allowance. Applicant should specifically authorize cancellation of the present specification to the same. Further, a clean copy and marked up copy (showing any addition, deletion, and/or modification) of the substitute specification should be submitted.

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Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kent L. Bell whose telephone number is (703) 306-3224. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached at (703) 308-4205.

The fax phone number for the group is (703) 305-3014 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

K. L. Bell

KENT L. BELL
PATENT EXAMINER

Kent L. Bell

Detailed Action

REQUIREMENT FOR INFORMATION UNDER 37 CFR 1.105

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined reasonably necessary to the examination of this application.

The information is required to determine when, if ever, the claimed plant variety, 'Penjul', was publicly available prior to the filing date of the instant application.

In response to this requirement please provide any information available regarding the sale or other public distribution of the claimed plant variety anywhere in the world, including the date(s) of any sale or other public distribution. Also, please provide copies of the published European Community application, 981667, and Poland application, OO00777. The Office does not maintain a collection of Breeders' Rights documents and they are not readily obtainable electronically. It is reasonable to expect that Applicant can readily obtain the requested document(s) and information.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

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Applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete response to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is three months.